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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/707,184

11/25/2003

Peter T. Kazlas

H-360

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26245

7590

08/14/2008

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EXAMINER

NGUYEN, KHIEM D

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/707,184	Applicant(s) KAZLAS ET AL.	
	Examiner KHIEM D. NGUYEN	Art Unit 2823	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14, 15 and 24-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 15 and 24-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. Applicants' amendment to the title is greatly appreciated.

Response to Arguments

2. Applicants' arguments, see pages 6-7, filed May 28th, 2008, with respect to the rejection(s) of claim(s) 1-15 and 24-26 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Kohara et al. (U.S. Patent 6,212,057). Applicants' arguments with respect to claims 1-12, 14-15 and 24-26 are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-2 and 5-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kohara et al (U.S. Patent 6,212,057).

In re claim 1, **Kohara et al.** disclose a backplane for use in an electro-optic display, the backplane comprising a patterned metal foil **9** having a plurality

of apertures **10** extending therethrough, coated on at least one side with an insulating polymeric material **1**, and having a plurality of thin film electronic devices (thin film capacitors) provided on the insulating polymeric material **1**, whereby the insulating polymeric material **1** separates the thin film electronic device from the patterned metal foil **9** (see col. 7, lines 2-26 and FIG. 6).

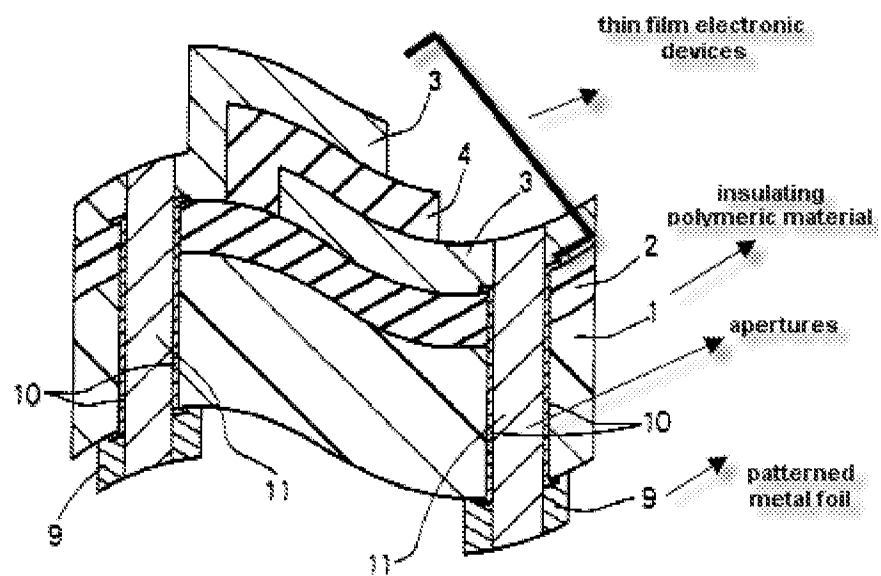


FIG. 6

In re claim 2, as applied to claim 1 above, **Kohara et al.** disclose all claimed limitations including the limitation wherein the apertures are arranged on a rectangular grid (see FIG. 6).

In re claim 5, as applied to claim 1 above, **Kohara et al.** disclose all claimed limitations including the limitation wherein the patterned metal foil **9** is coated on both sides with an insulating polymeric material **1** (see FIG. 1). Note

that, Applicants' claimed invention does not clearly specify wherein both sides of the patterned metal foil comprise a top side opposite to a bottom side.

In re claim 6, as applied to claim 5 above, **Kohara et al.** disclose all claimed limitations including the limitation wherein the patterned metal foil **9** is coated on both sides with the same insulating polymeric material **1** (see FIG. 1). Note that, Applicants' claimed invention does not clearly specify wherein both sides of the patterned metal foil comprise a top side opposite to a bottom side.

In re claim 7, as applied to claim 5 above, **Kohara et al.** disclose all claimed limitations including the limitation wherein the patterned metal foil **9** is coated on its two sides with different insulating polymeric materials (see FIG. 1). Note that, Applicants' claimed invention does not clearly specify wherein both sides of the patterned metal foil comprise a top side opposite to a bottom side.

In re claim 8, as applied to claim 1 above, **Kohara et al.** disclose all claimed limitations including the limitation wherein each of the thin film electronic devices (thin film capacitor) lies entirely within the area of one aperture in the metal foil **9** (see col. 7, lines 2-26 and FIG. 6).

In re claim 9, as applied to claim 1 above, **Kohara et al.** disclose all claimed limitations including the limitation wherein each of the thin film electronic devices extends across a plurality of apertures in the metal foil **9** (see col. 7, lines 2-26 and FIG. 6).

In re claim 10, as applied to claim 1 above, **Kohara et al.** disclose all claimed limitations including an electro-optic display comprising a backplane according to claim 1 (see col. 7, lines 2-26 and FIG. 6).

In re claim 11, as applied to claim 10 above, **Kohara et al.** disclose all claimed limitations including an encapsulated electrophoretic electro-optic medium (see col. 7, lines 2-26 and FIG. 6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-4, 12, 14, 15, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kohara et al (U.S. Patent 6,212,057).

In re claims 3 and 4, as applied to claim 1 Paragraph 4 above, **Kohara et al.** is silent about wherein the apertures occupy at least about 30 percent or at least about 60 percent of the area of the patterned metal foil.

However, there is no evidence indicating the percentage range that the apertures occupy the area of the patterned metal foil is critical and it has been held that it is not inventive to discover the optimum or workable percentage range of a result-effective variable within given prior art conditions by routine experimentation. See MPEP § 2144.05.

Note that the specification contains no disclosure of either the critical nature of the claimed dimensions of any unexpected results arising there from. Where patentability is aid to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

In re claim 12, **Kohara et al.** disclose a backplane for use in an electro-optic display, the backplane comprising a metal foil **9** coated on at least one side with an insulating polymeric material **1** and having a plurality of thin film electronic devices provided on the insulating polymeric material **1**, the backplane further comprising at least one conductive via **10** extending through the polymeric material **1** and electrically connecting (via electrically conductive paste **11**) at least one of the thin film electronic device (thin film capacitors) to the metal foil **9**, wherein the metal foil serves as at least one of an antenna, an inductor loop, a power plane, a capacitor, a capacitor contact, a pixel electrode, and electromagnetic induction shielding (see col. 7, lines 2-26 and FIG. 6).

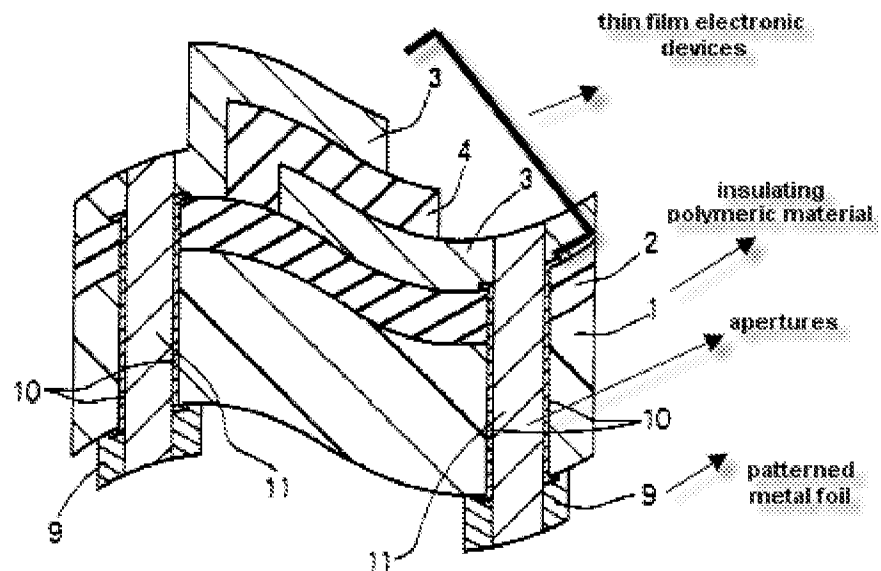


FIG. 6

With respect to “wherein the metal foil serves as at least one of an antenna, an inductor loop, a power plane, a capacitor, a capacitor contact, a pixel electrode, and electromagnetic induction shielding”, **Kohara et al.**’ structure is substantially identical to the claimed structure, therefore, it is capable of performing/serving the same functions.

In re claim 14, as applied to claim 12 above, **Kohara et al.** disclose all claimed limitations including an electro-optic display comprising a backplane according to claim 12 (see col. 7, lines 2-26 and FIG. 6).

In re claim 15, **Kohara et al.** disclose an electro-optic display comprising a backplane, the backplane comprising a metal foil **9** coated on at least one side with an insulating polymeric material **1** and having a plurality of thin film

electronic devices provided on the insulating polymeric material **1**, the backplane further comprising at least one conductive via **10** extending through the polymeric material **1** and electrically connecting (via electrically conductive paste **11**) at least one of the thin film electronic devices (thin film capacitors) to the metal foil **9**, the electro-optic display having the form a smart card, the metal foil serving to communication between the card and a card reading apparatus (see col. 7, lines 2-26 and FIG. 6).

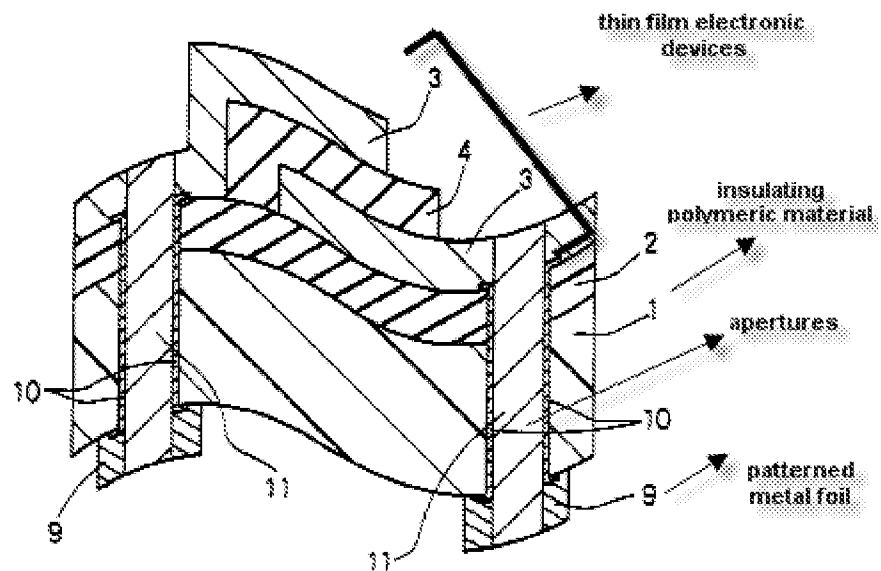
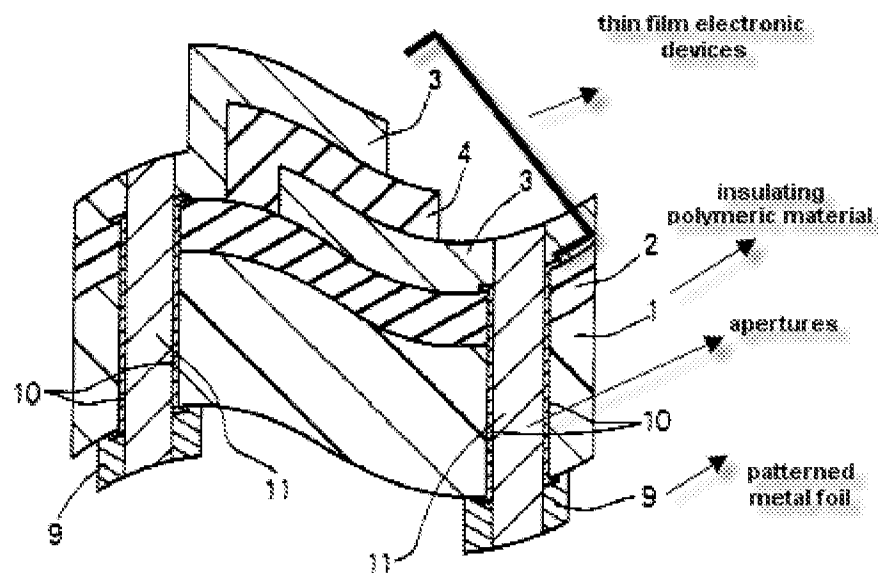


FIG. 6

With respect to “the metal foil serving to communication between the card and a card reading apparatus”, **Kohara et al.**’ structure is substantially identical to the claimed structure, therefore, it is capable of performing/serving the same functions.

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In re claim 24, **Kohara et al.** disclose an electro-optic display having a metal substrate **5** (see col. 5, line 66 to col. 6, line 4), the display having a central portion comprising an electro-optic material and means for writing an image on the electro-optic material, and a peripheral portion extending around at least part of the periphery of the central portion, the peripheral portion having an aperture extending through the metal substrate **5**, by means of which apertures the electro-optic display may be stitched to a flexible medium (see col. 7, lines 2-26 and FIG. 6).



11/6/83

With respect to “means for writing an image on the electro-optic material” and “by means of which apertures the electro-optic display may be stitched to a

flexible medium”, **Kohara et al.**’ structure is substantially identical to the claimed structure, therefore, it is capable of performing/serving the same functions.

In re claim 25, as applied to claim 24 above, **Kohara et al.** disclose all claimed limitations including the limitation wherein the peripheral portion of such a display is free from the electro-optic material (see FIG. 6).

In re claim 26, as applied to claim 24 above, **Kohara et al.** disclose all claimed limitations including the limitation wherein the peripheral portion extends completely around the central portion so that the entire periphery of the electro-optic display can be stitched to the flexible medium (see FIG. 6).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHIEM D. NGUYEN whose telephone number is (571)272-1865. The examiner can normally be reached on Monday-Friday (8:30 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Matthew S. Smith can be reached on (571) 272-1907.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kiem D. Nguyen/
Examiner, Art Unit 2823

/K. D. N./
Examiner, Art Unit 2823